corrected properly." Office Action, pages 2-3. Applicants respectfully traverse the rejection and the Examiner's requirement for the following reasons.

First, the Specification of the present application provides definition of the term "upconverter." For example, in the Section titled "Description of the Related Art," the term "upconverter" is defined as follows:

> A frequency upconverter generally includes an RF amplifier to amplify a radio frequency ("RF") input signal, a local oscillator ("LO") to generate a LO signal and a mixer to combine the RF input and LO signals to generate an intermediate frequency.

Specification, page 1, lines 10-13. Throughout the Specification, the word "upconverter" has been consistently used to refer to a device defined as such. In addition, claim 1 recites, *inter alia*, "[a]n upconverter for modulating an input signal to provide an output signal having a higher frequency than said input signal." Therefore, despite the Examiner's citation of Tiller, the use of the term "upconverter" in drafting the claims is proper. The Federal Circuit has repeatedly held "that a patentee can act as his own lexicographer to specifically define terms of a claim contrary to their ordinary meaning." Process Control Corp. v. Hydreclaim Corp., 190 F.3d 1350, 1357, 52 U.S.P.Q.2d 1029, 1033 (Fed. Cir. 1999) (citing Digital Biometrics v. Identix, Inc., 149 F.3d 1335, 1344 (Fed. Cir. 1998)). See also M.P.E.P. § 2173.05 (a). Even if the Examiner's allegations were correct, Applicants are allowed to, and are free to, define the meaning of an "upconverter" in a way different than others' definition, as long as the term is clearly defined in the Specification. The Examiner's requirement that Applicants use certain language in a certain way to conform with the prior art found by the Examiner is inappropriate.

Second, the definition of term "upconverter" in the Specification is clear and unambiguous to one skilled in the art. Applicants note that the test for whether a claim meets the definiteness requirement is "whether one skilled in the art would understand the

bounds of the claim when read in light of the specification." Process Control, 190 F.3d at 1358 n.2, 52 U.S.P.Q.2d at 1034 n.2. As long as "the claims when read in light of the specification reasonably apprise those skilled in the art of the scope of the invention, [35 U.S.C.] § 112 demands no more." S3, Inc. v. Nvidia Corp., 259 F.3d 1364, 1367, 59 U.S.P.Q.2d 1745, 1746-47 (Fed. Cir. 2001) (quoting Miles Laboratories, Inc. v. Shandon, 997 F.2d 870, 875, 27 U.S.P.Q.2d 1123, 1126 (Fed. Cir. 1993)).

As discussed above, an "upconverter" is clearly defined in the Specification as a device that converts an RF input signal into an IF signal. Claim 1 calls for "an upconverter" that modulates "an input signal to provide an output signal having a higher frequency than said input signal." Therefore, the scope of the claim is clear to one skilled in the art. The Examiner should not look to other sources when interpreting a term used in a claim when the Specification provides clear and unambiguous definition thereof. Indeed, "the specification is always highly relevant to the claim construction analysis. Usually, it is dispositive; it is the single best guide to the meaning of a disputed term." Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576 , 1582 (Fed. Cir. 1996). At least on this basis, the rejection of claims 1-31 under 35 U.S.C. § 112, second paragraph, should be withdrawn.

In view of the foregoing remarks, Applicants respectfully request the reconsideration of this application and the timely allowance of the pending claims 1-31.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, L.L.P.

Dated: May 28, 2004

By: _____
Qingyu Yin*

*With limited recognition under 37 C.F.R. § 10.9(b).

BEFORE THE OFFICE OF ENROLLMENT AND DISCIPLINE
UNITED STATE PATENT AND TRADEMARK OFFICE

LIMITED RECOGNITION UNDER 37 CFR § 10.9(b)

Mr. Qingyu Yin is hereby given limited recognition under 37 CFR §10.9(b) as an employee of Finnegan, Henderson, Farabow, Garrett & Dunner LLP to prepare and prosecute patent applications wherein the patent applicant is the client of Finnegan, Henderson, Farabow, Garrett & Dunner LLP, and the attorney or agent of record in the applications is a registered practitioner who is a member of Finnegan, Henderson, Farabow, Garrett & Dunner LLP. This limited recognition shall expire on the date appearing below, or when whichever of the following events first occurs prior to the date appearing below: (i) Mr. Qingyu Yin ceases to lawfully reside in the United States, (ii) Mr. Qingyu Yin's employment with Finnegan, Henderson, Farabow, Garrett & Dunner LLP ceases or is terminated, or (iii) Mr. Qingyu Yin ceases to remain or reside in the United States on an H-1B visa.

This document constitutes proof of such recognition. The original of this document is on file in the Office of Enrollment and Discipline of the U.S. Patent and Trademark Office.

Expires: June 6, 2004

Harry I. Moatz
Director of Enrollment and Discipline